

Remarks/Arguments

The specification has been amended to correct minor grammatical and translational errors. No new matter has been added. Claims 8-14 have been cancelled as being drawn to a nonelected invention. Claims 1-3 and 15-18 remain pending in this application. Claim 1 is amended to indicate that the composition comprises an extract obtained from specific plants (i.e., at least one of Citrus tachibana and Citrus unshiu) having a polymethoxyflavone. The amendment is supported on page 9, the fourth full paragraph and page 12, the second full paragraph. Claims 2, 3, 15, and 17 were amended to be consistent with Claim 1. Typographical errors in claims 17 and 18 are also corrected.

Claims 1-3 and 15-18 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Examiner indicates that the terms “lower alcohol” and “polymethoxyflavones” are unclear. The claims have been amended to address the Examiner’s rejections. Therefore, the rejection of claims 1-3 and 15-18 under 35 U.S.C. § 112, second paragraph should be withdrawn.

As reflected in amended claim 1, the present invention is directed to a cosmetic composition that includes an extract obtained from at least one of Citrus tachibana and Citrus unshiu; a specific amount of a specific polymethoxyflavone; a specific amount of a whitening agent; and other required substances such as water, alcohols, oils, and the like. The inventive composition has an excellent whitening effect.

A distinctive feature of the present invention is that a specific plant extract (i.e. an extract from at least one of Citrus tachibana and Citrus unshiu) is required in the cosmetic composition in order to obtain the desired whitening effect.

Claims 1-3 and 16-18 stand rejected under 35 U.S.C. § 103(a) as being obvious over United States Patent No. 5,916,576 to Dornoff et al. (hereinafter "Dornoff") in view of United States Patent No. 3,598,841 to Swift (hereinafter "Swift") and GB 2 259 014 A to Hadas et al. (hereinafter "Hadas"). The Examiner indicates that Swift teaches that the juice squeezed from orange peels contains nobiletin and closely related compounds at about 0.1% gram per liter and, therefore, Swift establishes that nobiletin and related compounds are inherently present in the extracts taught by Dornoff in amounts overlapping with the claimed percentage. Applicants respectfully disagree.

Dornoff does not disclose a plant extract obtained from *Citrus tachibana* or *Citrus unshiu* or that these specific plants cause a whitening effect when the plant extract is included in a cosmetic composition.

In order to demonstrate that plant extracts obtained from different kinds of plants provide a varying whitening effect, Mr. Shinji Hayashi, one of the inventors of the present invention, conducted certain experiments which are described in a Declaration Under 37 C.F.R. § 1.132 submitted herewith. In Mr. Hayashi's experiments, an orange extract, "Pharcolex Orange," was employed as an orange extract test sample. This Pharcolex Orange satisfies the standard of orange extract described in the Japanese Cosmetic Ingredients Codex. Pharcolex Orange was used under the assumption that nobiletin is contained in Pharcolex Orange in an amount of 0.1 grams per liter as disclosed by Swift.

In the experiments, extracts from *Citrus tachibana* (i.e., kippi extract), Pharcolex Orange, and polymethoxyflavone compounds (II), (III), (IV), and (V) were used in an amount of 10 μ M in a medium, which corresponds to about 0.0004% of polymethoxyflavone(s), to evaluate the whitening effect in the same manner as described on

page 17 of the present specification. In the kippi extract, the polymethoxyflavone compounds (II), (III), (IV), and (V) were included.

As the results of the experiments indicate, a whitening effect was obtained in the experiment where the kippi extract was employed, and the degree of the effect derived from the kippi extract was the same level as in the experiment where each of the polymethoxyflavone compounds (II) to (V) were employed. However, when Pharcolex Orange (orange extract) was employed, a whitening effect was not obtained. Furthermore, the data indicate that the orange extract negatively impacted the whitening effect. The differences in the results appear to be derived from the differences in the plant extracts.

The data demonstrate that an extract obtained from a specific plant indicated in claim 1 (Citrus tachibana) provides an excellent whitening effect. As there is not indication or motivation in Dornoff and/or Swift that would lead one skilled in the art to this surprising result, the present invention is novel, and would not have been obvious based on the combined teachings of Dornoff and Swift.

Hadas describes neither the extract obtained from Citrus tachibana nor the extract obtained from Citrus unshiu. Further, Hadas fails to describe the specific polymethoxyflavone shown by formula (I) having at least four substituents as defined in claim 1 of the present invention. Additionally, Hadas fails to describe a combination of such an extract and a specific whitening agent in specific amounts as described in claim 1 of the present invention. Hadas merely describes a flavonoid derived from plant extracts and a composition containing such a flavonoid and kojic acid. (See page 2, the first and second paragraphs, and the abstract of Hadas.) Therefore, Hadas does not provide any disclosure, motivation, or teaching that would have directed a skilled artisan to modify Dornoff and/or



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Swift to arrive at the presently claimed invention, and the amended claims are not obvious over any combination of Dornoff, Swift and/or Hadas.

Therefore, the rejection of claims 1-3 and 15-18 under 35 U.S.C. § 103(a) should be withdrawn.

In view of the above amendments and remarks, reconsideration of the rejections and allowance of claims 1-3 and 15-18 are respectfully requested.

Respectfully submitted,

WEBB ZIESENHEIM LOGSDON
ORKIN & HANSON, P.C.

By

Kent E. Baldauf
Registration No. 25,826
Attorney for Applicants
700 Koppers Building
436 Seventh Avenue
Pittsburgh, PA 15219-1818
Telephone: (412) 471-8815
Facsimile: (412) 471-4094
E-mail: webblaw@webblaw.com